

as polyvinyl alcohol, gelatin and cellulose and a hardener such as boron compound (col. 13, line 61 and col. 15, line 52). Majumdar and Ohbayashi are analogous art because they are from the same field of endeavor that is the recording sheet art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ink absorptive layer of Ohbayashi with the invention of Majumdar so as to provide a recording sheet having enhanced image quality, drying property and water resistance property.

5. In Majumdar, the layer between the support and the image layer does not comprise water swellable synthetic mica as claimed. However, Serizawa teaches a recording material comprising a support, a resin layer on the support and a recording layer on the resin layer (abstract). The resin layer comprises a binder such as gelatin and polyvinyl alcohol, and water swellable synthetic mica having an aspect ratio of 100 or more ([0022], [0043] and [0061]-[0065]). Majumdar and Serizawa are analogous art because they are from the same field of endeavor that is the recording medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the resin layer of Serizawa with the invention of Majumdar in order to prevent printed image defects (see [0024] of Serizawa).

Response to Arguments

6. Applicant's argument is based on that the primary reference and the declarations filed on 08/21/2006 and 11/21/2006 support the unexpected superior properties of the present application over the teaching of the primary reference (see page 7 of

Applicant's Remarks). This argument is not persuasive for the following reason. The Examiner carefully reviewed both of the declarations filed on 08/21/2006 and 11/21/2006. The current rejection is not based on only the teaching of Majumdar, it is based on the combined teaching of Majumdar and Serizawa. Serizawa is combined with Majumdar to teach the claimed water swellable synthetic mica having aspect ratio of 100 or more. Both declarations show that smectite clay is distinct from water swellable synthetic mica. However, Serizawa expressly teaches the claimed water swellable synthetic mica.

7. Applicant further argued that Serizawa discloses that the resin layer containing the water swellable synthetic mica is between the recording layer and the support, and that the reference does not disclose the resin layer can be used as a backcoat layer (see page 7 of Applicant's remark). This argument is not persuasive for the following reason. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the resin layer of Serizawa is provided between the support and the recording layer (abstract and [0023]), wherein the resin layer comprises water swellable synthetic mica having an aspect ratio of 100 or more ([0061]-[0065]). The resin layer of Serizawa is combined with the invention of Majumdar. Majumdar expressly teaches applying the layer containing mica to be applied on both

sides of the substrate. Thus the combination of Serizawa and Majumdar teach the claimed backcoat layer and the claimed undercoat layer. Furthermore, Serizawa does not expressly exclude applying the resin layer as a backcoat layer. In fact, Serizawa teaches the recording layer can be coated by a dip coating method [0177], and the resin layer is provided between the support and the recording layer [0023]. When the dip coating method is used to coat the recording layer, the recording layer must be applied on both sides of the support. Thus since the resin layer is provided between the support and the recording layer, it would be impossible to conclude that the resin layer of Serizawa cannot be used as backcoat layer as argued by the Applicant.

8. Applicant argued that it would not have been obvious to one having ordinary skill in the art to implement the resin layer disclosed in Serizawa as material for a backcoat layer in Majumdar (see page 10 of Applicant's Remarks). This argument is not persuasive for the following reason. The resin layer of Serizawa is provided between the support and the recording layer (abstract and [0023]), wherein the resin layer comprises water swellable synthetic mica having an aspect ratio of 100 or more ([0061]-[0065]). The resin layer of Serizawa is combined with the invention of Majumdar. Majumdar expressly teaches applying the layer containing mica to be applied on both sides of the substrate. Thus the combination of Serizawa and Majumdar teach the claimed backcoat layer and the claimed undercoat layer. Furthermore, Serizawa does not expressly exclude applying the resin layer as a backcoat layer. In fact, Serizawa teaches the recording layer can be coated by a dip coating method [0177], and the resin layer is provided between the support and the recording layer [0023]. When the dip

coating method is used to coat the recording layer, the recording layer must be applied on both sides of the support. Thus since the resin layer is provided between the support and the recording layer, it would be impossible to conclude that the resin layer of Serizawa cannot be used as backcoat layer as argued by the Applicant.

9. Applicant argued that one having ordinary skill in the art would not have been motivated to combine Serizawa with Majumdar, as the two references relate to two different technical fields. In this regard, Majumdar relates to the technical field of inkjet printing versus Serizawa, which relates to the technical field of heat-sensitive or pressure-sensitive recording (see page 10 of Applicant's Remarks). This argument is not persuasive for the following reason. The imaging element of Majumdar is not limited to the use of an ink jet imaging member only. The imaging member of Majumdar includes thermal transfer and xerographic imaging (see col. 3, lines 54-57), which include the use of heat and/or pressure.

10. Applicant argued that the declarations submitted on August 21, 2006 and November 21, 2006, are relevant to the present rejection, and support patentability of the presently claimed invention. Applicants respectfully request that the Office reconsider the declarations as evidence in support of nonobviousness, and demonstrate the unexpected superior properties of the presently claimed invention over the disclosure of the primary reference, Majumdar (see page 10 of Applicant's Remarks). This argument is not persuasive for the following reason. The current rejection is not based on only the teaching of Majumdar, it is based on the combined teaching of Majumdar and Serizawa. Serizawa is combined with Majumdar to teach the claimed

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS
October 10, 2008.

/Betelhem Shewareged/
Primary Examiner, Art Unit 1794.